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EXAMINER

SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/681,722

Applicant(s)

GREGORY R. WYATT

Examiner

Sandra Snapp

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WY

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10,12-17 and 19-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3,5-10,12-17 and 19-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

Currently, claims 1-3, 5-10, 12-17 and 19-24 remain in the application. New claims 25-27 were added with the Amendment dated 2-5-4.

***Drawings***

The drawings were previously objected to however the Examiner did not provide reasoning for such objection. The Examiner apologizes for this oversight. In view of the substitute drawings filed with the Amendment of 2-5-4 the drawings are herein accepted and any previous objection is withdrawn.

***Oath/Declaration***

The new declaration submitted with the Amendment filed 2-5-4 is accepted.

***Claim Objections***

The objection to claim 11 is rendered moot in view of the cancellation of claim 11 in the Amendment of 2-5-4.

***Claim Rejections - 35 USC § 112***

Claims 1-16 and 18 were previously rejected under 35 U.S.C. 112, first paragraph, as nonenabling. The rejection of claims 1-16 and 18 for nonenablement purposes is herein withdrawn.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-7 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 5-7 and 25 are indefinite because they are directed to a "system" wherein the preamble states a server and network, yet the body of the claim is directed to a method. Is the applicant claiming a method or an apparatus? Clarification is required.

Claims 22-24 are indefinite because it is unclear how the means for receiving, means for developing and the means for combining lead to the means for receiving purchase contract bids from the supplier. In other words there does not appear to be any nexus between the tangible result (the receiving of purchase contract bids) and the remaining limitations in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5-7, 17, 19-25 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-3, 5-7, 17, 19-25 and 27 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims. The Patent Office has taken the position that some form of technology must

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be claimed in the body of the claims. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory because they do not provide a useful, concrete and tangible result. While it appears (in claim 17) as though the step of “receiving purchase contract bids from suppliers” may be intended to be a useful, concrete and tangible result, it is not consistent with the remaining steps in claim 17. That is, there is no connection between the steps of prompting, developing, combining, and transmitting with the step of receiving and as such, the claim is not clear, definite and statutory.

Claims 17-21 are also directed to non-statutory subject matter because they are apparatus claims that define the apparatus in terms of functional language. According to 2114 of the M.P.E.P. “claims directed to [an] apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). ‘[A]pparatus claims cover what a device *is*, not what a device *does*.’ *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).”

***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by the Huang et al. patent.

The Huang patent discloses a method for facilitating the auctioning of a pricing model using a network based system including a server and at least one device connected to the server via a network, the method comprising the steps of:

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Receiving product listing and pricing information data from multiple suppliers (col. 55, line 50 through col. 57, line 5), developing an initial regression equation for each supplier based on received product listing and pricing information data (col. 55, line 50 through col. 57, line 5), combining the initial regression equations for each of the suppliers into a final regression equation for a product line (col. 55, line 50 through col. 57, line 5) (claim 1);

Posting the final regression equation to the suppliers along with required products (display, col. 5, lines 33-43) (claim 2);

Receiving purchase contract bids from suppliers (col. 12, line 51 through col. 13, line 7) (claim 3);

Providing suppliers a matrix showing desired products to be used in developing mathematical models (col. 22, lines 64-65) (claim 5);

Providing a spreadsheet of desired products in which at least one of the suppliers can enter pricing information (col. 21, line 45 through col. 22, line 5) (claim 6); and

Transmitting to the suppliers a bid sheet (col. 5, lines 10-32) (claim 7).

The Huang patent discloses a system for facilitating the auctioning of purchase contracts for engineered products by implementing pricing models, the system comprising:

At least one device (col. 4, line 50 through col. 5, line 61), a server configured to receive product listing and pricing information data from multiple suppliers, develop an initial regression equation for each supplier utilizing received product listing and pricing information data, and combine the initial regression equations into a final regression equation for a product line (col. 5,

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lines 10-32 and col. 55, line 50 through col. 57, line 5), and a network connecting the at least one device to the server (col. 5, lines 10-32) (claim 8);

The server is further configured:

to post the final regression equation along with required products to enable bids from suppliers (col. 5, lines 33-43) (claim 9);

to receive purchase contract bids from suppliers (col. 12, line 51 through col. 13, line 7) (claim 10);

to provide suppliers a matrix showing desired products to be used in developing mathematical models (col. 22, lines 64-65) (claim 12);

to provide a spreadsheet of desired product, the spreadsheet configured to receive pricing information entered by the supplier (col. 21, line 45 through col. 22, line 5) (claim 13);

transmit a bid sheet to the at least one device (col. 5, lines 10-32) (claim 14);

to accept coefficients into the initial regression equation from a supplier (col. 54, lines 18-62) (claim 15); and

the network is one of a wide area network, a local area network, an intranet and the Internet (col. 5, lines 10-32) (claim 16).

The Huang patent discloses a computer programmed to:

to prompt a user to enter product listing and pricing information data from multiple suppliers (col. 55, line 50 through col. 57, line 5), develop an initial regression equation for each supplier based on the product listing and pricing information data (col. 55, line 50 through col. 57, line 5), combine the initial regression equations for each of the suppliers into a final



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regression equation for a product line (col. 55, line 50 through col. 57, line 5), transmit to the suppliers the final regression equation and a list of required products (col. 55, line 50 through col. 57, line 5), and receive purchase contract bids from suppliers (col. 12, line 51 through col. 13, line 7) (claim 17);

to transmit to suppliers a matrix showing desired products to be used in developing mathematical models (col. 22, lines 64-65) (claim 19);

to transmit to suppliers a spreadsheet of desired products into which at least one of the suppliers can enter pricing information (col. 21, line 45 through col. 22, line 5) (claim 20); and

to transmit to the suppliers a bid sheet (col. 5, lines 10-32) (claim 21).

The Huang patent discloses an apparatus comprising:

Means for receiving product listing and pricing information data from multiple suppliers (col. 55, line 50 through col. 57, line 5), means for developing an initial regression equation for each supplier based on received product listing and pricing information data (col. 55, line 50 through col. 57, line 5), means for combining the initial regression equations for each of the suppliers into a final regression equation for a product line (col. 55, line 50 through col. 57, line 5) and means for receiving purchase contract bids from suppliers (col. 12, line 51 through col. 13, line 7) (claim 22);

Means for transmitting to the suppliers the combined regression equation and the products to enable bids from the suppliers (col. 55, line 50 through col. 57, line 5) (claim 23);

Means for providing suppliers a matrix illustrating desired products to be used in developing mathematical models (col. 22, lines 64-65), and means for providing a spreadsheet of

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desired products into which a supplier can enter pricing information (col. 21, line 45 through col. 22, line 5) (claim 24).

***Allowable Subject Matter***

Any prior indication of allowable subject matter is herein withdrawn in view of the new rejections stated in this Office Action.

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: neither the Huang patent, nor any of the cited prior art, disclose an auction system having a server configured to generate a final regression equation according to the specific equation recited in claim 26.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

ss

April 27, 2004

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PATENT EXAMINER  
GROUP 3600